

### **REMARKS/ARGUMENTS**

The rejections presented in the Office Action dated August 25, 2006 (hereinafter “Office Action”) have been considered. Reconsideration of the pending claims and allowance of the application in view of the present response is respectfully requested.

With respect to the §101 rejection of Claim 22, Applicant has amended the claim in accordance with the Examiner’s suggestions. Support for this amendment may be found in the instant Specification at page 13, lines 5-36. The amendment does not introduce new matter and is believed to overcome the rejection. Thus, Applicant requests that the rejection be withdrawn.

Applicant respectfully traverses the §112, first paragraph, rejection of Claim 21 because the claim is not a “single means” claim, and the Specification clearly teaches the subject matter that is claimed. MPEP §2164.01 indicates that determining whether a particular claim is supported by the disclosure in an application requires a determination of whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention. Instead, the Examiner has asserted that Claim 21 is a “single means” claim despite the fact that Claim 21 is not written in “means plus function” format. While a claim dependent upon a recited property could result in a fact situation similar to that discussed in the cited *Hyatt* decision, such is not the case for Claim 21. Contrary to the cited portion of MPEP §2164.08, Claim 21 includes multiple properties, not a single property as discussed; therefore, each of the recited properties limits the subject matter of Claim 21. The Specification describes the limitations of Claim 21 at least at page 6, lines 1-7 and 21-25; page 12, lines 33-36; and in Claim 7. In view of the claim language of Claim 21 and the corresponding discussion in the Specification, Claim 21 is not “unduly broad” and is enabled by the instant Specification. Thus, the rejection appears to be improper and Applicant requests that it be withdrawn. If the Examiner were to maintain the §112 rejection, Applicant requests further clarification and the opportunity to respond.

Applicant respectfully traverses the §103(a) rejection of Claims 1-22 based on U.S. Patent No. 6,829,484 to Kimoto *et al.* (hereinafter “Kimoto”) in view of U.S. Publication

No. 2002/0087542 to Itabashi (hereinafter “Itabashi”) because the cited references, alone or in combination, do not teach or suggest each of the claimed limitations. Contrary to the Examiner’s assertion, Kimoto does not teach determining substantially the geographical coverage area of the cell, as claimed. The cited portion of Kimoto at column 7, lines 10-28 does not teach any determining of geographical coverage area of a cell and instead merely teaches determining a base station identifier. While the cited portion teaches an inputting unit for inputting the position of a mobile terminal to request a map of such vicinity (*e.g.*, inputting “Ginza” to request a map of the “Ginza” vicinity), Kimoto makes no mention of determining the geographical coverage area of a cell. *See, e.g.*, column 35, lines 11-28. As the Examiner has not asserted that, nor does Applicant recognize where, Itabashi overcomes this deficiency in the teachings of Kimoto, the asserted combination of references fails to at least teach determining substantially the geographical coverage area of the cell, as claimed.

In view of the above discussion, Kimoto also does not teach the limitations directed to storing geographical coverage area information interlinked with encrypted cell-specific location information. The cited portion of Kimoto at column seven indicates that base station position identification information detected by a position information detecting unit (in a mobile terminal) and position identification information inputted in the mobile terminal are transmitted to a network and stored. However, Kimoto does not teach any storing of cell geographical coverage area information or interlinking of such cell geographic coverage area information with stored encrypted cell-specific location information. As Kimoto does not teach determining such geographic coverage information, Kimoto cannot teach storing or interlinking such information. Without a presentation of correspondence to each of the claimed limitations, the §103(a) rejection is improper. Applicant accordingly requests that it be withdrawn.

Moreover, the Office Action acknowledges that Kimoto fails to teach encrypting the cell-specific location information on at least one cell of the mobile communication network, as claimed. In an attempt to overcome this deficiency, the Office Action relies upon the teachings of Itabashi. However, this reliance is misplaced as Itabashi also fails to teach the claimed encrypting of cell-specific location information on at least one cell. The cited

portion at paragraph [0070] of Itabashi merely states that a communication terminal may encipher information transmitted to an information center via a base station and network. This information may include identification information of a cellular telephone [0071] or audio information [0064]. Such information is not, nor has the Office Action asserted that such information is, cell-specific location information, as claimed. Thus, neither of the cited references teaches the claimed encrypting of cell-specific location information. As neither Kimoto nor Itabashi teaches such limitations, any combination of these teachings must also fail to correspond to such limitations. Since each of the independent claims includes such limitations and correspondence to each of the claimed limitations has not been presented, the §103(a) rejection is improper and should not be maintained. Applicant accordingly requests that the rejection be withdrawn.

Dependent Claims 2-6, 8-13, and 15-20 depend from independent Claims 1, 7, and 14, respectively. Each of these dependent claims also stand rejected under 35 U.S.C. §103(a) as being unpatentable over the above-discussed combination of Kimoto and Itabashi. While Applicant does not acquiesce to any particular rejections to these dependent claims, including any assertions concerning descriptive material, obvious design choice and/or what may be otherwise well-known in the art, these rejections are moot in view of the remarks made in connection with independent Claims 1, 7 and 14. These dependent claims include all of the limitations of their respective base claims and any intervening claims, and recite additional features which further distinguish these claims from the cited references. "If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious." MPEP §2143.03; *citing In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Therefore, dependent Claims 2-6, 8-13 and 15-20 are also allowable over the asserted combination of Kimoto and Itabashi.

In addition to having to show that the cited combination of references teaches or suggests all of the claim limitations, the Examiner must show evidence of motivation to combine these references. Applicant respectfully maintains that this requirement has not been met.

The Office Action proposes modifying Kimoto's mobile communicating system to include Itabashi's general teachings of encryption in order "to provide an information providing system which can prevent verification information or the like being observed or stolen at predetermined settlement locations, prevent unauthorized use, and allow settlement to be performed with a high degree of safety." However, this is not evidence of motivation to combine the asserted teachings but rather, is a generalized statement of what is asserted as being taught by Itabashi. Also, Kimoto is directed to a system providing map information deduced from position information of a mobile terminal by transferring a base station ID. *See, e.g.*, column 35, lines 11-26. Kimoto makes no reference to any sort of settlement or predetermined settlement locations. No evidence has been provided that a skilled artisan would have attempted to introduce the asserted encryption method of Itabashi to the teachings of Kimoto.

The examiner must show some objective teaching leading to the asserted combination. *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988). Since neither Kimoto nor Itabashi teaches any encryption of cell-specific location information, as discussed above, it is respectfully submitted that the teachings of Kimoto and Itabashi would have provided insufficient guidance for a skilled artisan having these references before him/her to make the combination suggested by the Examiner. Applicant respectfully asserts that the Examiner's conclusion of obviousness is, instead, based on improper hindsight reasoning using knowledge gleaned only from Applicant's disclosure. As stated by the Federal Circuit:

Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight.

*In re Dembiczak*, 50 USPQ2d 1614, (Fed. Cir. 1999) (*citing Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985)). Without a suggestion of the desirability of "the combination," a combination of such references is made in hindsight, and the "range of sources available, however, does not diminish the requirement for actual evidence." *Id.* It is a requirement that actual evidence of a suggestion, teaching or

motivation to combine prior art references be shown and that this evidence be “clear and particular.” *Id.* Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence. *Id.*

As neither Kimoto nor Itabashi teaches any encryption of cell-specific location information, Applicant respectfully submits that the asserted combination simply does not contemplate the proposed combination. This piecemeal selection of elements is tantamount to mixing teachings out of context. Such a rejection is not permissible under §103. *See In re Kotzab*, 217 F.3d 1365 (Fed. Cir. 2000) (proposed modification must not be made in the abstract but rather made in view of the entire teaching of the prior art).

There is nothing in the references or what is in the ordinary skill in the art that would lead to combining the cited references as asserted – rather, the proffered motivation is made in hindsight. For at least the aforementioned reasons, Applicant respectfully submits that a case of *prima facie* obviousness has not been satisfied for lack of a presentation of evidence of motivation to combine the cited references. Applicant accordingly requests that the rejections be withdrawn.

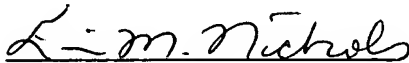
It should be noted that Applicant does not acquiesce to the Examiner’s statements or conclusions concerning what would have been obvious to one of ordinary skill in the art, obvious design choices, common knowledge at the time of Applicant’s invention, officially noticed facts, and the like. Applicant reserves the right to address in detail the Examiner’s characterizations, conclusions, and rejections in future prosecution.

Authorization is given to charge Deposit Account No. 50-3581 (KOLS.049PA) any necessary fees for this filing. If the Examiner believes it necessary or helpful, the undersigned attorney of record invites the Examiner to contact her at the number below to discuss any issues related to this case.

Respectfully submitted,

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By: 

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